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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/736,548      | 12/13/2000  | Uwe Schumann         | BEIERSDORF 685-WCG  | 5636             |

7590 05/29/2002

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[REDACTED] EXAMINER

CHANG, VICTOR S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1771     |              |

DATE MAILED: 05/29/2002 *6*

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                            |                  |
|------------------------------|----------------------------|------------------|
| <b>Office Action Summary</b> | Application No.            | Applicant(s)     |
|                              | 09/736,548                 | SCHUMANN ET AL.  |
|                              | Examiner<br>Victor S Chang | Art Unit<br>1771 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 should each be written in proper Markush format.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kinzer et al. (5667893).

Kinzer's invention is directed to a flexible tape backing comprising a substrate which has coated thereon a photopolymerizable, i.e., crosslinkable epoxy composition (Abstract). Kinzer teaches that the formation of polymerized, crosslinked epoxy materials is well known (column 1, lines 19-23). Kinzer further discloses the use of a flexible polyester backing having coated thereon a suitable epoxy to form an adhesive tape (column 2, lines 40-60). A plurality of epoxy resins including bisphenol A epoxy resins, cycloaliphatic epoxy resins, and aliphatic epoxy resins or mixtures can be used (column 2, lines 20-24). The epoxy coating compositions may also include hardeners, fillers, plasticizers, pigments, antioxidants, surface modifying agents, and the like (column 6, lines 17-21). Kinzer also teaches that the epoxy resins are fully cured after coating onto a tape backing (column 2, lines 40-52). Although Kinzer does not specifically state that the adhesive is a pressure-sensitive adhesive, note the citation (column 6, line 58) of acrylates such as in RE 24,906 (not RE 24,905) clearly indicates that pressure sensitive adhesive is applicable. As to the use of bisphenol F and A/F resins and the use of various amines as hardeners, they are each believed to be either inherently disclosed, or an obvious selection to one of ordinary skill. As such, if the reference is not considered to be an anticipation, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art to apply these aforementioned well-known elements to the instant claimed invention, motivated by the desire to obtain the desired improvement in backing flexibility and toughness.

6. Claims 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. (5667893) either individually, or in view of Wiest et al. (US 4322516) for claims 6 and 11.

The teachings of Kinzer are again relied upon as set forth above. Kinzer teaches that for an adhesive tape, depending on the use desired, one skilled in the art can easily select an adhesive for use with the tape backings of the invention. Useful adhesives, as mentioned above, include acrylate adhesives, etc. (column 6, lines 52-58). Although Kinzer lacks an express teaching of a release coating on top of the epoxy coating (claim 5), the specific adhesive compositions (claims 6, 11), and the thickness of the adhesive layer (claim 7), the Examiner takes Official notice that applying a release coating to advantageously form an adhesive tape roll and applying appropriate amount of acrylate adhesive as pressure-sensitive adhesive are well known. As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to apply these well known elements to modify Kinzer's adhesive tape, motivated by the desire to obtain a flexible tough pressure sensitive adhesive tape.

Alternatively, Wiest's patent provides an acrylic copolymer having good properties for use as a pressure-sensitive adhesive (Abstract). It is noticed that the scope of Wiest's monomer ratios are essentially the same as the instant claimed invention (claims 6, 11). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to combine Wiest's adhesive with Kinzer's epoxy coated polyester backing, motivated by the desire to obtain a flexible tough pressure sensitive adhesive tape.

Additionally, claim 8 employs only conventional method steps, and claim 10 is believed to be a well-known process of fabrication variation. As such, in the absence of unexpected results, they are rejected.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making tape masking tape:

RE 24906 to Ulrich

RE 24905 to Giffen

US 5102722 to Iida et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
May 21, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300  
1700

*Daniel Zirker*